

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today
(1) was not written for publication in a law journal and
(2) is not binding precedent of the Board.

Paper No. 11

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCE

Ex parte DIPEN N. SINHA

Appeal No. 97-0503
Application 08/218,102¹

ON BRIEF

Before KRASS, BARRETT and CARMICHAEL, ***Administrative Patent Judges.***

CARMICHAEL, ***Administrative Patent Judge.***

DECISION ON APPEAL

This is an appeal from the final rejection of claims 1-2 and 5-7, which constitute all the claims remaining in the application.

Claim 1 reads as follows:

¹ Application for patent filed March 25, 1994.

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1. Apparatus for comparing corresponding acoustical resonances in liquids, which comprises in combination:

a. first transducer means for applying a continuous periodic acoustical signal to the outside of a receptacle containing the liquid;

b. means for sweeping said first transducer means through a chosen frequency range;

c. second transducer means located on the same side of the receptacle as said first transducer means and in the vicinity thereof, for receiving the acoustical signal generated in the sample; and

d. means for measuring the resonant frequencies received by said second transducer means.

The Examiner's Answer cites the following prior art:

Pope et al. (Pope)	5,359,541	Oct. 25, 1994
Johnston et al. (Johnston)	5,426,977	Jun. 27, 1995

OPINION

The claims stand rejected under 35 U.S.C. § 103 as unpatentable over Johnston or Pope. The claims recite apparatus for comparing acoustical resonances in liquids, employing two transducers in the vicinity of one another on the same side of a container. Johnston and Pope each disclose similar apparatus whose two transducers are on opposite sides of the container. According to the examiner, placing the transducers on the same

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side as recited, instead of on opposite sides as in the prior art, would have been mere design choice.

Reliance on "obvious design choice" is precluded where the claimed structure and the function it performs are different from the prior art. ***In re Chu***, 66 F.3d 292, 298-99, 36 USPQ2d 1089, 1094-95 (Fed. Cir. 1995).

In the present case, the claimed structure and the function it performs are different from the prior art. Clearly, the structure is different; the transducers are in different locations. We find that the function is different as well. For example, appellant's specification indicates that a sharper resonance pattern is obtained if the transducers are placed in the vicinity of one another. Specification at 5, lines 29-34.

We recognize that the specification says that transducers may be located on opposing walls as well for some applications. We do not consider this an admission that the function is the same. It may be that some applications do not require the sharp resonance pattern that can be obtained if the transducers are placed in the vicinity of one another. The claims on appeal, however, are limited to placing the transducers in the vicinity of one another on the same side of a container.

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Moreover, the mere fact that the prior art may be modified in the manner suggested by the examiner does not make the modification obvious unless the prior art suggested the desirability of the modification. *In re Fritch*, 972 F.2d 1260, 1266 n.14, 23 USPQ2d 1780, 1783-84 n.14 (Fed. Cir. 1992). The examiner points to nothing in the prior art suggesting the desirability of the modification.

CONCLUSION

The rejections are not sustained.

REVERSED

ERROL A. KRASS)	
Administrative Patent Judge)	
)	
)	
)	
LEE E. BARRETT)	BOARD OF PATENT
Administrative Patent Judge)	APPEALS AND
)	INTERFERENCES
)	
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JAMES T. CARMICHAEL)	
Administrative Patent Judge)	

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